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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,333	10/12/2001	Jeffrey C. Hawkins	21495-05942	9245
758	7590	05/20/2004	EXAMINER ZHOU, TING	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			ART UNIT 2173	PAPER NUMBER

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/976,333

Applicant(s)

HAWKINS ET AL.

Examiner

Ting Zhou

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/1/02, 7/29/02, 12/29/03 and 4/9/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

BA HUYNH  
PRIMARY EXAMINER

### **DETAILED ACTION**

1. The applicants' claim of priority over Provisional Application No. 60/297,817, filed on 11 June 2001 has been noted.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Note reference characters "125" and "130" in Figure 1A; "130", "135", "140" and "145" in Figure 1B; "330-N" in Figure 3; and "440", "450-1", "450-2", "450-3", "450-4", "450-7", "450-10", "450-11", "450-12", "450-13" and "450-14" in Figure 4.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Note reference character "215" on line 1 of paragraph 0024; "625" on line 3 of paragraph 0041; and "450" on line 2 of paragraph 0038.

4. Applicant is required to submit a proposed drawing correction of the above noted deficiencies in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

#### ***Specification***

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5. The disclosure is objected to because of the following informalities:
- a. The use of "215-n" on lines 4 and 5 of paragraph 0023, line 8 of paragraph 0024 and line 3 of paragraph 0031 does not correspond with the reference characters on the drawings. It is suggested that the use of "215-n" be changed to -- 215-D --.
  - b. The use of "240-n" on line 3 of paragraph 0025 does not correspond with the reference character on the drawings. It is suggested that the use of "240-n" be changed to -- 240-N --.
  - c. The use of "625-n" on line 3 of paragraph 0041 does not correspond with the reference character on the drawings. It is suggested that the use of "625-n" be changed to -- 625-N --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Will U.S. Patent 5,825,353.

Referring to claims 1, 6 and 11, Will teaches a handheld device comprising a first button to cause a cursor to navigate through a plurality of menu items and to highlight a

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desired menu item (the thumbwheel allows users to navigate through a plurality of menu items such as "Datebook", "Calendar", "Directory", etc. and highlight a desired menu item, such as "Directory") (column 2, lines 56-66 and Figure 1), and a second button to cause the cursor to navigate through a plurality of menus when the cursor is highlighting one of the menus or a first menu item, and to cause the cursor to highlight a previous menu item when the cursor is highlighting a menu item other than the first menu item (for example, if the "Time" item in the main menu shown in Figure 1 is chosen by highlighting the item and selecting it with the selector button, then the "Time" sub-menu shown in Figure 8e will be displayed and the user will be able to navigate through the sub-menu using the up and down functions of the thumbwheel to highlight particular items; the user navigates through the handheld personal assistant by using the up and down scrolling buttons of the thumbwheel). This is further recited in column 4, lines 53-67, column 7, lines 41-50 and column 18, lines 17-24.

Referring to claims 2, 7 and 12, Will teaches a third button to cause the device to display the plurality of menus (pressing the selector button to display the menus associated with the highlighted item) (column 2, lines 60-67, column 4, lines 53-67 and column 7, lines 41-50)

Referring to claims 3, 8 and 13, Will teaches an execute button to execute the highlighted item (pressing the selector button) (column 2, lines 60-67 and Figure 1).

Referring to claims 4, 9 and 14, Will teaches the highlighted item being a telephone number (column 3, lines 54-59, column 4, lines 33-37 and column 13, lines 9-22). This is further shown in Figure 12c.

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Referring to claims 5, 10 and 15, Will teaches a button to dial the telephone number (the "Dial" button represented by reference character "201" in Figure 12c).

Referring to claim 16, Will teaches a menu bar including a plurality of menus (column 2, lines 56-67 and Figure 1), a set of items associated with each menu of the plurality of menus (each menu, such as "Datebook", "Calendar", etc. has a set of items, or a sub-menu associated with it) (column 3, lines 22-40), a display button to cause the menu bar including the plurality of menus to be displayed (the selector button causing the display of menu items) (column 5, lines 7-8), a first scroll button to selectively highlight one of the plurality of menus of the displayed menu bar and to cause the set of items associated with the highlighted menu to be displayed (the thumbwheel allows users to navigate and highlight through a plurality of menu items such as "Datebook", "Calendar", "Directory", etc. and if "Directory" is selected for example, items associated with the "Directory" will be displayed) (column 2, lines 56-66 and Figure 1), a second scroll button to cause the cursor to selectively highlight one of the set of items of the highlighted menu (for example, if the "Time" item in the main menu shown in Figure 1 is chosen by highlighting the item and selecting it with the selector button, then the "Time" sub-menu shown in Figure 8e will be displayed and the user will be able to navigate through the sub-menu using the up and down functions of the thumbwheel to highlight particular items); and a command execute button to execute the highlighted item (pressing the selector button). This is further recited in column 4, lines 53-67, column 7, lines 41-50 and column 18, lines 17-24.

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7. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar handheld devices comprising scrolling buttons for navigating through menu systems.

### ***Conclusion***

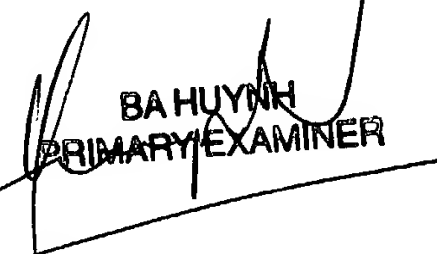
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703) 305-0328.

The examiner can normally be reached on Monday - Friday 8:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 11, 2004

  
BA HUYNH  
PRIMARY EXAMINER